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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/399,192	09/17/1999	JOHN WANKMUELLER	AP31994-0704	1972
7590 BAKER & BOTTS LLP 30 ROCKEFELLER PLAZA NEW YORK, NY 101120228		01/10/2008	EXAMINER HEWITT II, CALVIN L	
			ART UNIT 3621	PAPER NUMBER
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/399,192

Applicant(s)

WANKMUELLER ET AL.

Examiner

Calvin L. Hewitt II

Art Unit

3621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 September 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13, 17-29, 33-45, 49 and 50 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-13, 17-29, 33-45, 49 and 50 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

Status of Claims

1. Claims 1-13, 17-29, 33-45, 49 and 50 have been examined.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 20, 21 and 33-45 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 33 is directed to an apparatus. However, the claim also recites method steps (e.g. "... cause the processor to perform the steps of..."). It has been held that a claim that recites both an apparatus and a method for using said apparatus is indefinite under section 112, paragraph 2 (*IPXL Holdings LLC v. Amazon.com Inc.*, 77 USPQ2d 1140 (CA FC 2005); *Ex parte Lyell*, 17 USPQ2d 1548 (B.P.A.I. 1990)). Therefore, claim 33 is rejected at least as it does not sufficiently provide an accurate determination of the 'metes and bounds' of the Applicant's apparatus (*IPXL Holdings LLC v. Amazon.com Inc.*, 77 USPQ2d 1140 (CA FC 2005); *Ex parte Lyell*, 17 USPQ2d 1548 (B.P.A.I. 1990)). Claims

20, 25 (i.e. wherein the cryptographic operation uses...) and 34-45 are also rejected as each recites language similar to claim 33.

Claims 21 and 34-45 are also rejected as each depends from either claim 29 or 33.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-13, 17-29, 33-45, 49 and 50 are rejected under 35 U.S.C. 103(a) as being unpatentable over Walker et al., U.S. Patent No. 6,163,771 in view of Everett et al., U.S. Patent No. 6,575,372.

As per claims 1-13, 17-29, 33-45, 49 and 50, Walker et al. teach a method for generating identification data comprising:

- providing a first numerical code (i.e. credit card number/account number) (figure 5, item 501, figure 13; column 7, lines 45-48 and lines 60-61; column 8, lines 20-25; column 11, lines 25-40)

- generating a second numerical code on a central computer by performing a cryptographic operation (e.g. addition or subtraction) (column 8, lines 19-25) on the first numerical code (figure 13; column 11, lines 25-40) and cryptographically computed data (column 7, lines 62-64; column 8, lines 13-17; column 11, lines 25-40)
- providing a conversion key and using the conversion key to perform the cryptographic operation on the first code (column 8, lines 16-25)
- deriving the conversion key by cryptographically (e.g. DES) (column 9, lines 10-20; column 10, lines 5-10) applying a (secret) deriving key to conversion key (initial) data (column 7, lines 62-64; column 8, lines 13-17; column 11, lines 25-40)
- generating cryptographically computed data (column 7, lines 62-64; column 8, lines 13-17; column 11, lines 25-40) wherein the data has the same base (e.g. 2 or 10) as the first numerical code (figure 5, item 501)

Walker et al. do not specifically apply their method to the generation of PINs.

However, a PIN is merely a numerical code and Walker et al. teach that their numerical codes can be of arbitrary length (e.g. a-bit account number-column 7,

lines 60-61 and column 11, lines 25-40). Also, it is well known that a PIN can be of any given length. In addition, in the context of Applicant's claim a PIN is merely intended use and Walker et al. do disclose entering both the first and second numbers for engaging in a financial transaction (column/line 1/5-2/62; column 11, lines 45-62). Therefore, it would have been obvious to one of ordinary skill to apply the method of Walker et al. generating numbers that can be used as a PIN. Walker et al. also [inherently] teach manually providing a user with a card wherein the card is pre-stored with a second numerical code (column 11, lines 25-40). It has been held that invention is not the replacing of a manual activity with a mechanical or automatic means which accomplishes the same result (*In re Venner*, 120 USPQ 192 (CCPA 1958); *In re Rundell*, 9 USPQ 220 (CCPA 1931); *Leapfrog Ent., Inc. v. Fisher-Price, Inc.*, 82 USPQ2d 1687 (Fed. Cir. 2007)), hence, it would have been obvious to one of ordinary skill to automate the process of providing second codes by transmitting the codes to a device such as a smart card (figure 1; column 5, lines 49-61) over a network. On the other hand, Everett et al. teach transmitting card data (column 8, lines 40-67) such as card numbers (column 2, lines 46-54) to a smart card (column 3, lines 42-55) over a network (column 8, lines 40-67). Therefore, it would have been obvious to one of ordinary skill to combine the teachings of Walker et al. and Everett et al. in order to allow a credit card issuer to update card data without having to go through the expense of providing a new card to a user ('372, column 3, lines 53-67).

As per claims 5 and 9-11, Applicant attempts to limit the claimed method by further describing the derivation data. However, it has been held that data stored in computer memory that is not functionally related to the memory will not differentiate a claimed method from the prior art (*In re Gulack*, 217 USPQ 401 (Fed. Cir. 1983), *In re Ngai*, 70 USPQ2d (Fed. Cir. 2004), *In re Lowry*, 32 USPQ2d 1031 (Fed. Cir. 1994); MPEP 2106.01 II). Hence, the composition of the claimed derivation data cannot be relied upon to distinguish the claimed from the teachings of Walker et al. (column 7, lines 62-64; column 8, lines 13-17).

As per claims 20-21, and 33-45, it has been held that while features of an apparatus may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function alone (MPEP 2114; *In re Swineheart*, 169 USPQ 226; *In re Schreiber*, 44 USPQ2d 1429 (Fed. Cir. 1997)). Therefore, how Applicant's apparatus is intended to perform will not differentiate the claims from the prior art.

Conclusion

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

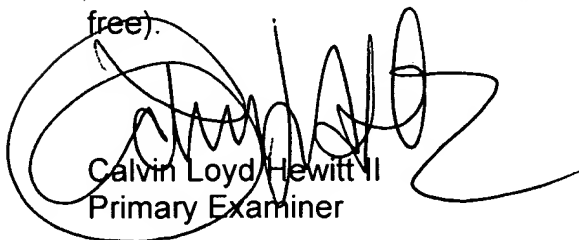
- Zingher et al. disclose PINs of N digits

7. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Calvin Loyd Hewitt II whose telephone number is (571) 272-6709. The Examiner can normally be reached on Monday-Friday from 8:30 AM-5:00 PM.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Andrew Fischer, can be reached at (571) 272-6779.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-

free).



Calvin Loyd Hewitt II
Primary Examiner

January 7, 2008